

REMARKS

Claims 1 and 3-20 are pending in this application.

Applicant has amended claims 1, 11, 13, and 17, and has canceled claim 2. In addition, Applicant has made minor changes to the specification. These changes do not introduce any new matter.

Claim Objections

In response to the objection to claims 1, 11, 13, and 17, Applicant has amended these claims so that they no longer include parentheses. Accordingly, Applicant requests that the objection to claims 1, 11, 13, and 17 be withdrawn.

Rejection Under 35 U.S.C. § 112

Applicant respectfully requests reconsideration of the rejection of claims 1, 11, 13, and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite. In response to the Examiner's indefiniteness concerns, Applicant has amended each of claims 1, 11, 13, and 17 to clarify the meaning of parameters Nc and Nm (claims 1, 13, and 17) and Mc and Mm (claim 11). In the case of Nc and Mc, one having ordinary skill in the art could readily determine whether a number is a positive integer. In the case of Nm and Mc, one having ordinary skill in the art could readily determine whether a number is an integer that is greater than the positive integer represented by either Nc or Mc. As such, one having ordinary skill in the art could readily determine the metes and bounds of the presently claimed subject matter. Accordingly, Applicant submits that claims 1, 11, 13, and 17, as amended herein, satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, and requests that the rejection of these claims thereunder be withdrawn.

Rejections Under 35 U.S.C. § 101

Applicant respectfully requests reconsideration of the rejection of claims 13 and 17 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Considering

first claim 13, Applicant has amended this claim to specify that each step of the method for generating modified image data by modifying color tones of an image in image data is executed by a microprocessor. Thus, present claim 13 defines subject matter that is eligible for protection under 35 U.S.C. § 101 (see the PTO's "Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101" dated August 2009).

Turning to claim 17, Applicant has amended this claim to specify that the computer-readable medium is a computer-readable *storage* medium. In addition, Applicant has amended the specification to remove the references to the computer program being either embedded in a carrier wave or temporarily stored in a carrier wave. As such, present claim 17 is directed toward statutory subject matter.

Accordingly, in view of the foregoing, Applicant requests that the rejection of claims 13 and 17 under 35 U.S.C. § 101 be withdrawn.

Rejection Under 35 U.S.C. § 103

Applicant respectfully requests reconsideration of the rejection of claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over *Kubo et al.* ("*Kubo*") (US 2003/0095269 A1) in view of *Shimada* (US 2005/0219618 A1) (as noted above, claim 2 has been canceled). As will be explained in more detail below, the combination of *Kubo* in view of *Shimada* would not have suggested to one having ordinary skill in the art the subject matter defined in independent claims 1, 13, and 17, as amended herein.

Applicant has amended each of independent claims 1, 13, and 17 to specify that each of the plurality of modification candidate parameters corresponds to modification which converts tone values of a primary color in a color system into tone values of the same primary color, or modification which converts tone values of lightness into tone values of lightness. Support for the changes to the independent claims can be found in Applicant's specification (see the substitute specification at, for example, page 3, lines 6-9).

Neither the *Kubo* reference nor the *Shimada* reference discloses or suggests 1) selecting a parameter from a plurality of modification candidate parameters corresponding to modifications of a primary color or lightness, or 2) that the number of the plurality of modification candidate parameters differs depending upon whether the modification candidate parameters are monochrome or colored.

In formulating the obviousness rejection, the Examiner appears to recognize *Kubo's* "selection" of colors C, M, Y and density D in Figures 5 and 7 as corresponding to "selecting a parameter from a plurality of modification candidate parameters," as specified in the claimed subject matter. While the configuration defined in present claim 1 allows the user to select a parameter from the Nc color image modification candidate parameters *and* allows the user to select a parameter from the Nm monochrome image modification candidate parameters, *Kubo's* configuration is able to select multiple modification targets from colors C, M, Y and density D.

Furthermore, in the presently claimed configuration, each of the plurality of modification candidate parameters represents a different mode or extent of conversion that is carried out within the tone value of the same primary color or lightness (see Figures 2, 3, and 7 of the subject application). On the other hand, *Kubo's* C, M, Y, and D represent the conversion of different basic colors (or densities).

Thus, even if the *Kubo* and *Shimada* references were to be combined in the manner proposed by the Examiner, the result of this combination would not have included each and every feature of the presently claimed subject matter. As such, the combination of *Kubo* in view of *Shimada* would not have rendered the presently claimed subject matter obvious to one having ordinary skill in the art.

Accordingly, for at least the foregoing reasons, independent claims 1, 13, and 17, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of *Kubo* in

Application No. 10/590,572
Amendment dated September 10, 2009
Response to Office Action mailed June 10, 2009

view of *Shimada*. Claims 3-12, each of which ultimately depends from claim 1, claims 14-16, each of which ultimately depends from claim 13, and claims 18-20, each of which ultimately depends from claim 17, are likewise patentable under 35 U.S.C. § 103(a) over the combination of *Kubo* in view of *Shimada* for at least the same reasons set forth above with regard to the applicable independent claim.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1 and 3-20, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP190).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.



Peter B. Martine
Reg. No. 32,043

710 Lakeway Drive, Suite 200
Sunnyvale, California 94085
Customer Number 25920